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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/816,036

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John A. Salentine

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EXAMINER

LARSON, JUSTIN MATTHEW

ART UNIT

PAPER NUMBER

3782

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/816,036	<b>Applicant(s)</b> SALENTINE ET AL.	
	<b>Examiner</b> Justin M. Larson	<b>Art Unit</b> 3782	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-14 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-14 and 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2004 and 19 July 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/14/08 has been entered.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the pivoting ball must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-4, 6-14, and 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the claims recite a pivoting ball attached to a personal device. Nowhere have any structural details of this pivoting ball been shown or described in Applicant's originally filed disclosure. Examiner notes that Applicant admits that such pivoting balls can be found on Nokia cell phones and invites Applicant to provide any supporting reference or documentation that may be available.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-4, 6-14, and 16-18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, it is unclear if Applicant is claiming the subcombination of only a holster or the combination of a holster with a personal device. First, claims 1 and 11 both positively set forth structural details of the holster and include functional language stating that a tether of the holster can be attached to a personal device. In particular, the language, "arranged to allow an electronic personal device to be mounted to said tether housing with said extendable/retractable tether attached to said personal device" seems to suggest that Applicant is claiming only a subcombination holster that is capable of allowing an electronic personal device to be mounted to said tether housing with said extendable/retractable tether attached to said personal device. Then, claims 1 and 11 both positively set forth structural details of the personal device by reciting, "said personal device comprises a pivoting ball arranged in said elevated slot." This language seems to suggest that the personal device is being in combination with the holster.

For the purpose of examination, Examiner is treating the claims as claiming only the subcombination holster, where the holster includes a tether housing, a spring, a mounting apparatus, and a U-shaped elevated slot. Examiner is of the position that any holster having these features such that the holster's elevated slot is capable of receiving the pivoting ball of a personal device will satisfy the limitations of the claims, even if no such personal device is disclosed in combination with the holster.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-4, 7-14, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Thompson et al. (US 5,524,749 A).

Regarding claims 1 and 11, Thompson et al. disclose a tethering system comprising a tether housing (12b) having an internal tether (16) that is extendable, an internal spring (col. 3 line 25) for biasing the tether into a retracted position, a mounting apparatus (20) integral to said tether housing for mounting said housing on a person, and a holstering system (12a) integral to said tether housing, said tether being extendable, wherein said holstering system comprises a substantially U-shaped elevated slot (pocket formed in portion 12a has the shape and configuration of an elevated U-shaped slot). The initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Thompson et al. which is capable of being used in the intended manner, i.e., allowing an electronic personal device having a pivoting ball to be removably mounted within the elevated slot where

the tether is attached to the personal device to allow use of the personal device while also preventing the device from falling to the ground when the tether housing is mounted. There is no structure in Thompson et al. that would prohibit such functional intended use (see MPEP 2111). An electronic device having a pivoting ball could certainly be attached to the tether in place of cards (24-27) and the pivoting ball could be held in some manner in the elevated slot/pocket.

Regarding claims 2 and 12, the device of Thompson et al. includes a lanyard loop (see esp. Figures 1B-1C) between said tether housing and said personal device, effectively satisfying the limitations of the claim. Examiner notes that when configured as shown in Figures 1B-1C, the button (22) could be pressed to lock the tether in place making it such that the personal device was mounted to the housing without there being tension on the tether.

Regarding claims 3 and 13, the device of Thomson et al. includes a lanyard attachment (30) that prevents said tether from fully retracting into said tether housing.

Regarding claims 4 and 14, the initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Thompson et al. which is capable of being used in the intended manner, i.e., the elevated slot (pocket) receiving a pivoting ball of a personal device. There is no structure in Thompson et al. that would prohibit such functional intended use (see MPEP 2111).

Regarding claims 7 and 17, the device of Thompson et al. includes a ratchet lock (22) to hold said tether at a desired extended length. Examiner notes that no structure

of Applicant's ratchet lock is set forth in the claims that would define over the lock of Thompson et al. Both serve to hold a tether at a desired length.

Regarding claims 8 and 9, the tether of Thompson et al. can be considered to extend through either a top or front surface of the housing, depending on how the housing is viewed.

Regarding claims 10 and 18, Thompson et al. teach that the mounting device may include a mounting clip (20a, Figure 4A).

9. Claims 1, 4, and 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Wong (US 6,546,103 B1).

Regarding claims 1 and 4, Wong discloses a tethering system comprising a tether housing (10) having an internal tether (12) that is extendable, a mounting apparatus (40/41) integral to said tether housing, and a holstering system (30) integral to said tether housing and arranged to allow an electronic personal device (21) to be mounted to said tether housing with said tether attached to said personal device, said tether being extendable to allow use of said personal device while also preventing said personal device from falling to the ground when said tether housing is mounted, wherein said holstering system comprises a substantially U-shaped elevated slot (30). The initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Wong which is capable of being used in the intended manner, i.e., the elevated slot receiving a pivoting ball of a personal device. There is no structure in Wong that would prohibit such functional intended use (see MPEP 2111). A personal



device having a pivotable ball could be attached to the tether of Wong and that ball could be received in the elevated slot.

Regarding claims 8 and 9, the tether of Wong can be considered to extend through either a top or front surface of the housing, depending on how the housing is viewed.

Regarding claim 10, the device of Wong includes a mounting clip (40/41).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 4, 6, and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tien (US 5,620,120 A) in view of Wong.

Regarding claims 1 and 4, Tien discloses a system comprising a mounting apparatus (20/21) and a holstering system (11) arranged to allow an electronic personal device to be mounted thereto, wherein said holstering system comprises a substantially U-shaped elevated slot (100). Tien fails to disclose a tether housing coupled between the mounting apparatus and the holstering system, wherein the tether housing includes an extendable/retractable tether attachable to said electronic personal device.

Wong, however, teaches that it is desirable to provide a tether housing (10) with a tether (12) between a mounting apparatus (40/41) and a holstering system (30) so that a portable electronic device will not accidentally fall to the ground and be damaged

or get lost. It would have been obvious to one having ordinary skill in the art at the time the invention was made to implement a tether housing and tether between the mounting apparatus (20/21) and holstering system (11) of Tien, as taught by Wong, so that the personal electronic device of Tien would not fall to the ground and become damaged or lost.

The initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over the modified Tien device which is capable of being used in the intended manner, i.e., the elevated slot receiving a pivoting ball of a personal device. There is no structure in the modified Tien device that would prohibit such functional intended use (see MPEP 2111).

Regarding claim 6, a leg (13) of the U-shaped elevated slot of the modified Tien device comprises a hinge (18/140) that acts in securing a personal device in the slot.

Regarding claims 8 and 9, the tether of the modified Tien device can be considered to extend through either a top or front surface of the housing, depending on how the housing is viewed.

Regarding claim 10, the modified Tien device includes a mounting clip (21).

12. Claims 11, 14, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tien in view of Wong as applied in paragraph 11 above, and further in view of Decoteau (US 6,502,727 B1).

The modified Tien device includes the claimed features except for there being a spring internal to said housing. The tether housing of Wong that has been implemented

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on the device of Tien is said to include a spool, but it is never specified that the spool acts upon a spring. Decoteau, however, teaches that it is known for such spools (32) to be spring (34) activated. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the spool of the modified Tien device spring activated, as taught by Decoteau, since such a spool mechanism is already known in the art and allows for an extendable/retractable spool/tether system.

### ***Response to Arguments***

13. Applicant has asserted that Thompson does not disclose the use of a retractable tether with a personal device, does not teach that the tether can prevent the personal device from falling to the ground, and does not teach a U-shape slot and pivoting ball arrangement. Examiner notes that the claims have been examined under the assumption that only the subcombination holster is being claimed. As set forth in paragraph 6 above, Examiner feels that the claims as currently presented do not cover a personal device having a pivoting ball in combination with a holster, only a holster that is capable of receiving a personal device having a pivoting ball. For these reasons, Examiner is of the position that while Thompson does not disclose a personal device having a pivoting ball, Thompson is capable of having its tether attached to a personal device with a pivoting ball such that the pivoting ball is received in the pocket of Thompson and the tether prevents the personal device from falling to the ground.

Applicant has generally asserted that Wong does not disclose all of the limitations of claim 1. Examiner notes that Wong, like Thompson, discloses a holster having a tether such that the tether is capable of being attached to a personal device

with a pivoting ball such that the pivoting ball is received in the slot of Wong and the tether prevents the personal device from falling to the ground

Applicant has asserted that the modified Tien device (Tien in view of Wong) does not include all features of the independent claims. Examiner notes that the modified Tien device, like Thompson and Wong individually, discloses a holster having a tether such that the tether is capable of being attached to a personal device with a pivoting ball such that the pivoting ball is received in the slot of the modified Tien device and the tether prevents the personal device from falling to the ground

Applicant has mistakenly asserted that a modified Wong device (Wong in view of Decoteau) was applied against claims 11, 14, and 18. Instead, a modified Tien device (Tien in view of Wong and further in view of Decoteau) has been applied against claims 11, 14, 16, and 18. Examiner notes that this modified Tien device, like Thompson and Wong individually, discloses a holster having a tether such that the tether is capable of being attached to a personal device with a pivoting ball such that the pivoting ball is received in the elevated slot of this modified Tien device and the tether prevents the personal device from falling to the ground

For Applicant's further consideration, Examiner notes that Tien discloses an elevated slot and that the personal device attached to this elevated slot includes a projection that is received in the elevated slot. Examiner also notes that Applicant has admitted in his own disclosure that pivoting balls are known in the art to exist on certain Nokia cell phones (see pages 1-2 of Applicant's originally filed disclosure) where the pivoting balls are received in the slots of holsters. Because Examiner does not feel that

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the combination personal device and holster has been set forth in the claims, no such rejection has been set forth, however, Examiner points out that Applicant's admitted prior art in combination with a reference like Tien results in a personal device having a projection in the form of a pivoting ball that is received in the elevated slot of a holster and Wong provides the motivation for a holster tether.

### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571) 272-8649. The examiner can normally be reached on Monday - Thursday, 6am-10am, 12pm-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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JML

2/28/08

/Nathan J. Newhouse/  
Supervisory Patent Examiner, Art Unit 3782